

Application No. 09/625,442	Filing Date July 26, 2000	First Named Applicant Patrick Hung	Attorney Docket No. CP0001
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I hereby certify that the following correspondence:

1. Petition Under 37 C.F.R. § 1.181
2. Exhibit A: copy of final Office action mailed August 25, 2003
3. Exhibit B: copy of Interview Summary mailed December 29, 2003
4. Exhibit C: copy of Amendment After Final Rejection Under 37 C.F.R. § 1.116 submitted January 20, 2004
5. Exhibit D: copy of Advisory Action mailed January 27, 2004
6. Exhibit E: copy of Amendment Filed with Request for Continued Examination Under 37 C.F.R. § 1.114 submitted February 24, 2004
7. Exhibit F: copy of Office action mailed March 18, 2004
8. return receipt postcard

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on May 18, 2004 by

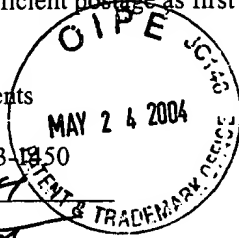
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On May 18, 2004
By Scott Hewett
Scott Hewett



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Attorney Docket No. CP0001US

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OFFICE OF PETITIONS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Inventor: Hung, P.

Application No.: 09/625,442

Filed: 07/26/2000

For: CONFIGURABLE ELECTRONIC
REDEEMABLE COUPON

Examiner: Carlson, J. D.

Art Unit: 3622

PETITION UNDER 37 C.F.R. § 1.181

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Sir:

The Applicant petitions the Director in the above-referenced matter under 37 C.F.R. § 1.181 (a)(1) or alternatively under 37 C.F.R. § 1.181(a)(3). If a fee is required, the Director is hereby authorized to deduct the necessary fee for a small entity from USPTO Deposit Account No. 50-0891.

Statement of the Facts Involved:

1. In the final Office action mailed August 25, 2003, attached as Exhibit A, the examiner rejected claim 8 of the patent application, which recited a configurable portable electronic device comprising a memory containing a computer-readable program for generating a scannable coupon on the electronic display from coupon information including instructions for converting the scannable coupon from a first barcode format to a second barcode format. The examiner cited a prior art reference that disclosed a device capable of displaying a coupon in an alphanumeric format and in a barcode format (see page 5 of Exhibit A).

2. In a telephonic interview on December 22, 2003, the examiner asserted that the alphanumeric coupon shown in the prior art reference can be taken to be a second barcode format. The examiner's Interview Summary is attached as Exhibit B.
3. In an Amendment After Final Rejection Under 37 C.F.R. § 1.116 filed by facsimile transmission on January 20, 2004 (attached as Exhibit C), the Applicant requested an affidavit in accordance with 37 C.F.R. § 1.1.4(d)(2) in order to provide the Applicant an opportunity for response regarding whether an electronic coupon displayed in an alphanumeric format is a barcode format, since the examiner, in light of the lack of citation to authority, apparently asserts this interpretation based upon his personal knowledge (see page 10 of Exhibit C).
4. In an Advisory Action mailed January 27, 2004 (attached as Exhibit D), the examiner indicated that the Amendment After Final Rejection Under 37 C.F.R. § 1.116 would not be entered because the proposed amendments raised new issues that would require further consideration and/or search, noting that the Amendment introduced new claim language not previously presented.
5. A Request for Continued Examination ("RCE") was filed on February 24, 2004, with an Amendment Filed with Request for Continued Examination Under 37 C.F.R. § 1.114 (attached as Exhibit E). The RCE requested entry of the Amendment After Final Rejection Under 37 C.F.R. § 1.116 before further examining the patent application.
6. A first Office action after the RCE (attached as Exhibit F) was mailed March 18, 2004. This Office action does not include the requested affidavit, and rejects claim 8 as being anticipated by the same prior art reference cited in the final Office action (Exhibit A).
7. The first Office action after the RCE substantially repeated the grounds of rejections for claims 1-9, 11-13, and 16 without appearing to address the amended claim language presented in the Amendment After Final Rejection Under 37 C.F.R. § 1.116, which the examiner had indicated in the Advisory Action raised new issues that would require further consideration and/or search.

8. In the first Office action after the RCE (Exhibit F), the Examiner cites International Publication Number WO 00/39657 by Greenberg et al. under 35 U.S.C. § 102(b) as prior art against claim 22, which was newly presented in the Amendment Filed with Request for Continued Examination Under 37 C.F.R. § 1.114 (Exhibit E, page 6).
9. 35 U.S.C. § 102(b) states that a person shall be entitled to a patent unless the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States.
10. The examiner has not asserted or provided evidence of the invention being in public use or on sale in this country more than one year prior to the date of the application for patent in the United states.
11. The instant patent application has a filing date July 26, 2000.
12. WO 00/39657 has an international publication date of July 6, 2000, which less than one year prior to the date of the instant application for patent in the United States.
13. In the first Office action after the RCE (Exhibit F), the examiner cites International Publication Number WO 00/39657 by Greenberg et al. under 35 U.S.C. § 103(a) as prior art against claim 23, which was newly presented in the Amendment Filed with Request for Continued Examination Under 37 C.F.R. § 1.114 on February 24, 2004 (Exhibit E, pages 6-7).
14. In the first Office action after the RCE (Exhibit F), the examiner cites U.S. Patent No. 6,532,375 by Cathey et al. as prior art against claim 22 under 35 U.S.C. § 103(a).
15. U.S. Patent No. 6,532,375 has a U.S. filing date of January 10, 2001, which is after the filing date of the instant patent application.
16. U.S. Patent No. 6,532,375 is a continuation of application No. 09/066,616, filed on April 24, 1998, now U.S. Patent No. 6,532,375, issued March 11, 2003.

17. 37 C.F.R. § 1.104 states that the examiner shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention, and, in rejecting the claims, must cite the best references at his or her command.

Points to be Reviewed:

1. Whether the examiner erred in not providing the affidavit under 37 C.F.R. § 1.1.4(d)(2) requested in the Amendment Filed with Request for Continued Examination Under 37 C.F.R. § 1.114.
2. Whether the examiner erred in not entering the Amendment After Final Rejection Under 37 C.F.R. § 1.116 or alternatively erred in not withdrawing the finality of the final Office action because the first Office action after the RCE did not appear to address the amended claim language presented in the Amendment After Final Rejection Under 37 C.F.R. § 1.116, and hence the amendments proposed in the Amendment After Final Rejection Under 37 C.F.R. § 1.116 did not appear to raise new issues that required further consideration and/or search.
3. Whether the examiner erred in rejecting amended claims 1-9, 11-13, and 16 in the first Office action after the RCE.
4. Whether the examiner erred in the rejection of claim 22 under 35 U.S.C. § 102(b) because WO 00/39657 has a publication date less than one year prior to the date of the application for patent in the United States and no public use or on-sale bar activity has been presented.
5. Whether the examiner erred in the rejection of claim 23 by citing WO 00/39657 under 35 U.S.C. § 103(a).
6. Whether the examiner erred in basing the rejection of claim 22 on U.S. Patent No. 6,532,375 under 35 U.S.C. § 103(a), which was filed after the instant application. Specifically, whether U.S. Patent No. 6,532,375 was the best reference at the examiner's command, in accordance with 37 C.F.R. § 1.104(c)(2).

7. Whether to invoke the supervisory authority of the Director in light of facts 1-17 and points 1-6, above.

Actions Requested:

1. That the Director exercise his supervisory authority to direct the examiner to issue the affidavit requested in accordance with 37 C.F.R. § 1.1.4(d)(2), or alternatively to vacate the examiner's rejection of claim 8 and to allow claim 8.
2. To refund the fee paid under 37 C.F.R. § 1.17(e) by the applicant in association with the RCE.
3. To vacate the rejections of claims 1-9, 11-13, and 16 and to allow claim 1 and all claims that depend from claim 1.
4. To vacate the rejection of claim 22 under 35 U.S.C. § 102(b) based on WO 00/39657.
5. To vacate the rejection of claim 23 under 35 U.S.C. § 103(a) based on WO 00/39657.
6. To vacate the rejection of claim 23 under 35 U.S.C. § 103(a) based on U.S. Patent No. 6,532,375.

REMARKS

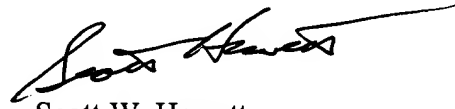
This petition is timely filed because the Points to be Reviewed arose only after the most recent Office action, which was mailed March 18, 2004. The Applicant urges that the examiner's refusal to enter the Amendment After Final Rejection Under 37 C.F.R. § 1.116 submitted January 20, 2004 directly resulted in requiring the Applicant to file the RCE. However, based on the most recent Office action, it appears that the Amendment After Final Rejection Under 37 C.F.R. § 1.116 did not raise new issues because the most recent Office action substantially repeated the grounds of rejections for claims 1-9, 11-13, and 16 without appearing to directly address the amended claim language in the rejections. Therefore, the Applicant respectfully urges that claim 1 and all claims that

depend from claim 1 are allowable, and respectfully requests a refund of the fee associated with filing the RCE.

The Applicant is entitled to the requested affidavit, regarding whether an electronic coupon displayed in an alphanumeric format is a barcode format, in accordance with 37 C.F.R. § 1.1.4(d)(2) in order to provide the Applicant an opportunity to directly contradict and/or explain the examiner's affidavit, by affidavits of the applicant and other persons.

The undersigned cordially invites the Director to telephone the undersigned at (707) 591-0789 if the Director has any questions or objections regarding this petition.

Respectfully Submitted

A handwritten signature in black ink, appearing to read "Scott W. Hewett", with a long horizontal flourish extending to the right.

Scott W. Hewett
Reg. No. 41, 836

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